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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,077	09/17/2003	Tsuneaki Kawanishi	H64-154708M/MNN	5060
21254	7590	09/20/2005	EXAMINER	
MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			RODEE, CHRISTOPHER D	
		ART UNIT		PAPER NUMBER
				1756

DATE MAILED: 09/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/664,077	KAWANISHI ET AL.
	Examiner	Art Unit
	Christopher RoDee	1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 August 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 4,5 and 8-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 4,5 and 8-19 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Specification

The reference to Figure 1 on page 44, line 13, should be to Figure 2 because this passage describes the apparatus of Figure 2. Correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 5, and 8-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as filed does not provide basis for the concept for continuous printing for the limitation "wherein by using the electrostatic charge image developing developer degradation of picture quality due to continuous printing is hard to occur". The specification does disclose "long-term" printing, but it is not apparent that "long-term" printing and "continuous" printing are the same concepts. "Long-term" would appear to permit

some pauses in the printing operation as long as printing occurred over a long period of time. "Continuous" printing could be as only for a few sheets, as long as the printing occurred without a pause. As presented, the claims contain new matter.

Dependent claim 8 also contains new matter because there is no apparent disclosure of the inventive apparatus as a high speed printer having a printer speed of greater than 10 pages per minute. New matter is present.

New dependent claim 10 contains new matter because there appear to be no basis in the specification as filed for the amount of carrier contamination specified. Various amounts of carrier contamination are present in Table 2, but none of these values is the same as claimed.

New dependent claim 12 also contains new matter because the specification only discloses a more specific fixing unit. The specification teaches, "In the fixing unit, a roller in which an aluminum core is coated thinly with a fluororesin (tetrafluoroethylene-perfluoroalkylvinylether copolymer: PFA) tube (thickness about 40 μ m) and a heater lamp is arranged at its center portion was used as the heat roller, and a roller in which the aluminum core is coated with a silicon rubber layer (thickness 7 mm) having a rubber hardness of about 30 degree and its outermost layer is coated with the PFA tube was used as the back-up roller." See spec. p. 35, l. 12-23. The claims permit any thickness of fluororesin layer and silicone rubber layer. The specification is specific as to the thickness of these layers and does not disclose any other thicknesses for the fixing unit.

New claim 16 is without basis in the specification as filed because the only disclosure of a center feed developing unit for a laser beam printer (p. 44, l. 23-25). The instant claims include other types of printers, such as reflective light copiers. The specification does not disclose the center feed developing unit for these other types of printers. Similarly, new claim

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17 is without basis in the specification as filed because the respective rotation of the developers is only for a center feed unit in a laser printer (see spec. p. 44, l. 23 – p. 45, l. 3).

New claim 18 also is without basis in the specification because the only disclosure of printing characteristics at 50,000 pages is for Comparative Example 5. There appears to be no disclosure of this number of pages reproduced or the effects for this number of pages in this comparative example.

Claims 4, 5, and 8-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The instant claims recite both an apparatus and a method of using the apparatus in the same claims. For example, claim 4 recited various apparatus limitation and then states “wherein by using the electrostatic charge image developing developer degradation of picture quality due to continuous printing is hard to occur.” Clearly the apparatus is being limited by the method in which it is being used. This renders the apparatus claim indefinite because two categories of invention are simultaneously recited. Claims 8, 12, 14, 17, 18, and 19 also recite specific method steps that are used to define the apparatus of those claims. As discussed in MPEP 2173.05(p), “A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990).” Because the claims recite both an apparatus and a method in the same claim, the claims as presented are vague and indefinite. Also, in keeping with *Ex parte Lyell*, a rejection under section 101 follows.

The claims are also indefinite because it is unclear how the developer is “used” in the method steps of claim 4 and those dependent. As discussed in MPEP 2173.05(q), “Attempts to

claim a process without setting forth any steps involved in the process generally raises an issue of indefiniteness under 35 U.S.C. 112, second paragraph." It is unclear how the developer is used in the apparatus such that it will give the lack of picture degradation.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4, 5, and 8-19 are rejected under 35 U.S.C. 101 because of the reasoning given in the section 112, second paragraph, rejection above with respect to *Ex parte Lyell*, in that two statutory classes of invention are being claimed. As noted in MPEP 2173.05(p), claims having both apparatus and process limitations "should also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551."

Also, as noted in *Lyell*, "since the appealed claims are indefinite and indeterminate in scope for the reasons stated *supra*, it is not possible to apply the prior art to these claims in deciding patentability without disregarding portions of the express wording of the claims and thus resorting to speculation and conjecture as to the particular invention defined therein." No art has been applied against the instant claims for the same reason.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on most weekdays from 6:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cdr
15 September 2005



CHRISTOPHER RODEE
PRIMARY EXAMINER